

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
July 19, 2005

Mailed:
November 4, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Omega SA (Omega AG) (Omega Ltd.)

Serial No. 78192104

Jess M. Collen and Jane F. Collen of Collen IP,
Intellectual Property Law, P.C. for Omega SA (Omega AG)
(Omega Ltd.).

Michael Engel, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Omega SA (Omega AG) (Omega Ltd.)¹ has appealed from
the final refusal of the Trademark Examining Attorney to
register AQUA TERRA for goods that have been identified as
"jewelry, precious stones; watches, watch straps, watch
bracelets and parts thereof; chronometers, chronographs,

¹ Applicant has identified itself with these parentheticals in
its application.

watches made of precious metals, watches partly or entirely set with precious stones."² Registration has been refused on the basis that the term "chronographs" in the identification of goods is indefinite, and therefore unacceptable. 15 U.S.C. §1051(a)(2).

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

As noted, the sole issue on appeal is the acceptability of the term "chronographs" as an identification of goods. It is the Examining Attorney's position that "chronographs" per se is indefinite because these goods can be classified in more than one international class. Specifically, "chronographs for use as specialized time recording apparatuses" are classified in Class 9, whereas "chronographs for use as watches" or "chronographs for use as timepieces" are classified in Class 14.

Applicant argues that "chronograph" is a readily accepted term in the watch industry, and has made of record

² Application Serial No. 78192104, filed December 6, 2002, based on Section 1(a) of the Trademark Act, asserting first use and first use in commerce on July 18, 2002, and claiming a right of priority of June 11, 2002 under Section 44(d). Applicant has submitted a copy of the Swiss registration on which this application is also based.

an excerpt from the Illustrated Professional Dictionary of Horology I + II,³ in which the term is defined in French, Dutch, English and Spanish. The English-language entry for "chronograph" reads as follows:

CHRONOGRAPH n. (more properly chronoscope). A watch with hands showing the hours, minutes and seconds, together with a mechanism controlling a chronograph-hand mounted in the centre of the dial. By the operation of push-pieces, the chronograph-hand can be set in motion, stopped and returned to zero. It completes one revolution per minute; a *minute-counter hand* (U.S.A. *minute-register hand*) counts the revolutions, i.e., the minutes, usually up to 30.

Split-seconds chronograph. A chronograph with two push-pieces and a "split" seconds hand, i.e., two superimposed centre seconds hands: the ordinary chronograph-hand and the *fly-back hand*. It is used for timing several phenomena that start simultaneously but are of different duration. At the end of the first phenomenon, the fly-back hand is stopped, and the duration of the phenomenon can be read off on the dial; the fly-back hand is then made to overtake the first hand and continues to move with it. At the end of the second phenomenon, the fly-back hand is stopped again, and the duration is read off on the dial, and so on. After the last phenomenon, the two hands can be stopped and returned to zero. One of the push-pieces controls the fly-back hand alone, while the other controls both the hands.

Recording chronograph. In principle this apparatus consists of one or more electromagnets, whose mobile armatures each carry a point or a striker. The electromagnets are controlled by hand or automatically, to mark the exact time of a phenomenon (transmission of a signal, beat of a

³ G.-A. Berner "Sometime principal of the Biel School of Horology," © Société du Journal La Suisse Horlogère SA, Switzerland. The excerpt does not indicate the publication date.

pendulum, time of arrival or departure, etc.). A paper tape moves beneath the strikers at constant speed; one of the strikers at least marks a time-standard, e.g. one dot per second. The accuracy of the apparatus largely depends on the regularity of the paper-feed. To this effect, Hipp invented a mechanical vibrating-blade escapement (v. Hipp's vibrating-blade escapement 1660).

It is apparent from these listings that "chronograph" has more than one meaning. Applicant also acknowledges that "in English, the term chronograph has four separate meanings, most notably as a time keeping instrument comprising a time counter allowing measurement and display of time intervals independently of keeping the time of day." Brief, p. 4. A dictionary listing submitted by applicant also shows that the term has meanings of both a timepiece and a recoding device: "1. a timepiece fitted with a recording device, as a stylus and rotation drum, used to mark the exact instant of an occurrence, esp. in astronomy; 2. a timepiece capable of measuring extremely brief intervals of time accurately, as a stopwatch able to record fractions of a second as well as elapsed time."⁴

As the Examining Attorney has pointed out, Section 1402.03 of the Trademark Manual of Examining Procedure provides that a term which includes items which are

⁴ Webster's Encyclopedic Dictionary of the English Language, © 1996.

classified in more than one class is not acceptable as an identification. The record herein, including applicant's own statement and materials, shows that chronographs may be classified in both Class 9 and Class 14.

Applicant has argued that, because applicant has classified its goods in Class 14, it would be understood that "chronograph" means a watch or timepiece, and gives the example of the term "caps" which, if found in Class 25, would be viewed as headwear without the need for any further specification, even though caps could also mean ammunition for toy guns or "a short horizontal beam at the top of a prop for supporting part of a roof" or "a new tread applied to a worn pneumatic tire." Brief, p. 6. We are not persuaded by this argument. First, applicant's assumption that the identification "caps" would be acceptable as an identification for ammunition or a beam or a tire tread is incorrect. See the Acceptable Identification of Goods and Services Manual which lists, for example, "tire retreading caps" as an acceptable identification for goods in Class 12, and "caps for toy pistols" as an acceptable identification for goods in Class 28. Although "caps" per se may be acceptable as an identification for headwear because normally this term, without more, is associated with headwear, that is not the

case with other goods to which "caps" would apply, such as "bottle caps" or "dental caps" or "blasting caps."

Certainly given the different meanings of "chronograph," one cannot ascertain from such word alone whether the purpose of the chronograph is as a timepiece or as a specialized time recording apparatus. Chronographs are generally similar in kind, and therefore they may be distinguished with regard to their correct classification only by an indication of their purpose. In other words, one would not know their purpose (and therefore their classification) without this additional descriptive information.

Further, while a term must be viewed in context, context may not be provided solely by the class in which the item is placed. A major purpose of the Office registration records is to provide notice to the public of registered marks, and we cannot assume that all members of the public will be familiar with the international classification system, such that they will know that "chronographs" that are classified in Class 14 are timepieces rather than time recording apparatuses. Moreover, the classification of items can change.

Applicant has made of record third-party registrations in which the term "chronographs" per se has been accepted,

as well as pointing to its own registration which contains this term in the identification. Applicant also points to the International Classification of Goods and Services under the Nice Agreement, in which "chronographs" is listed as belonging in Class 14. In its reply brief, applicant also asserts that, as part of the United States's joining the Madrid Protocol, this country is now required to accept the WIPO-approved identification of "chronographs."

With regard to the latter point, it is presumed that applicant, in referring to the WIPO-approved identification, is actually referring to the International Classification of Goods and Services.⁵ However, this document is for the classification of goods, and does not require member countries to accept the goods listed in the various classes therein as the identification of those goods.

As to the various registrations submitted by applicant, although we recognize that in the past the term "chronographs" per se was accepted in some registrations, and although we agree that the Office should strive for consistency, we must also accept that practice must change

⁵ Office policy regarding the acceptability of identifications of goods and services is not affected by the Madrid Protocol. See TMEP §1402.01(c) regarding identification of goods and services in an application based on Section 66(a) of the Trademark Act (Madrid Protocol applications).

when there is a need for change. In view of the foregoing discussion, we consider the Office's position that "chronographs" per se is an indefinite term to be correct, and therefore the Examining Attorney's requirement for an acceptable identification of goods must be affirmed.

Decision: The refusal of registration is affirmed.